

THE HONORABLE ROBERT S. LASNIK

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

MARSHA LINEHAN, an individual,

No. 2:17-cv-01494 RSL

Plaintiff,

v.

LANE PEDERSON, an individual, and
COGNITIVE AND BEHAVIORAL
SPECIALTIES d/b/a DIALECTICAL
BEHAVIOR THERAPY NATIONAL
CERTIFICATION AND
ACCREDITATION
ASSOCIATION, a Minnesota non-profit
corporation,

ANSWER AND COUNTERCLAIM

JURY TRIAL REQUESTED

Defendants.

Defendants, Lane Pederson (“Dr. Pederson”) and Cognitive and Behavioral Specialties, doing business as Dialectical Behavior Therapy National Certification and Accreditation Association (“CBS”) (collectively, “Defendants”), for their Answer to the Complaint, deny each and every allegation of the Complaint, except as specifically admitted, qualified, or affirmatively alleged herein, and state as follows:

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PARTIES

1. Defendants deny the allegations of paragraph 1 for lack of information and belief.
2. Defendants admit the allegations of paragraph 2.
3. Defendants admit the allegations of paragraph 3.
4. As for paragraph 4, Defendants admit that the Complaint refers to Dr. Pederson and CBS as “Defendants.”

JURISDICTION AND VENUE

5. The allegations of paragraph 5 state a legal conclusion to which no answer is required. If an answer is required, Defendants admit that, by this action, Plaintiff purports to invoke the Court’s subject matter jurisdiction pursuant to the statutes cited therein.

6. Defendants deny the allegations of paragraph 6.
7. Defendants deny the allegations of paragraph 7.

FACTS

A. Defendants deny the allegations of paragraph A for lack of information and belief.

8. Defendants deny the allegations of paragraph 8 for lack of information and belief.
9. Defendants deny the allegations of paragraph 9.
10. Defendants deny the allegations of paragraph 10 for lack of information and belief.
11. Defendants deny the allegations of paragraph 11 for lack of information and belief.

B. Defendants deny the allegations of paragraph B.

12. As to paragraph 12, Defendants admit that Plaintiff filed a federal trademark application, Serial No. 85,161,464 and that in 2012 the U.S. Patent & Trademark Office (“USPTO”) granted U.S. Registration No. 4,204,315. Defendants deny the remaining allegations of paragraph 12 for lack of information and belief.

1 13. As to paragraph 13, Defendants admit that Plaintiff filed a trademark application,
2 Serial No. 86,539,349. Defendants deny the remaining allegations of paragraph 13 for lack of
3 information and belief.

4 14. Defendants deny the allegations of paragraph 14.

5 C. Defendants deny the allegations of paragraph C.

6 15. As for paragraph 15, Defendants admit that, since 2012, Dr. Pederson has written
7 at least three books on dialectical behavior therapy, commonly known by the associated acronym
8 DBT; that Dr. Pederson is a well-known, well-respected authority on dialectical behavior therapy
9 (DBT); and that he offers consultation and training on DBT through Lane Pederson
10 & Associates, LLC, and other business interests. Defendants deny the remaining allegations of
11 paragraph 15.

12 16. As for paragraph 16, Defendants admit that Dr. Pederson formed CBS in 2010 as
13 the first active program to certify dialectical behavior therapy (DBT) providers and accredit DBT
14 programs. In further answer, Defendants admit that CBS is the owner of the registered
15 trademarks **DBTNCAA** (word mark), as shown on Registration No. 4,099,711, and
16 **DIALECTICAL BEHAVIOR THERAPY NATIONAL CERTIFICATION AND**
17 **ACCREDITATION ASSOCIATION** (design mark), as shown on Registration No. 4,214,437.
18 Defendants deny that the logo infringes upon any trademark rights of Plaintiff and deny the
19 remaining allegations of paragraph 16.

20 17. As for paragraph 17, Defendants admit that CBS filed the cited trademark
21 applications and state that the applications speak for themselves. Defendants deny that the logo
22 infringes upon any trademark rights of Plaintiff and deny the remaining allegations of paragraph
23 17.

24 18. As for paragraph 18, Defendants state that the applications speak for themselves,
25 and no further answer is required.

1 19. As for paragraph 19, Defendants admit that, on September 10, 2010, the USPTO
2 issued an Office Action, which stated that CBS “must disclaim the descriptive wording
3 ‘dialectical behavior therapy’ and ‘national certification and accreditation association’ apart from
4 the [design] mark as shown because it merely describes the services provided by [CBS] and
5 describes [CBS] as an organization as well. *See* 15 U.S.C. §1056(a); TMEP §§1213,
6 1213.03(a).” The disclaimer of the words “dialectical behavior therapy” was stated on the record
7 without argument. Defendants deny that the logo infringes upon any trademark rights of Plaintiff
8 and deny the remaining allegations of paragraph 19.

9 20. As for paragraph 20, Defendants admit that the USPTO issued registrations for
10 the logo and the DBTNCAA mark in 2012. Defendants deny that the logo infringes upon any
11 trademark rights of Plaintiff. In addition, Registration Nos. 4,099,711 and 4,214,437 speak for
12 themselves, and no further answer is required.

13 21. As to paragraph 21, Defendants deny that the logo infringes upon any trademark
14 rights of Plaintiff. Defendants admit the remaining allegations of paragraph 21. In further
15 answer, Dr. Pederson’s interests include Opposers/Petitioners Lane Pederson & Associates, LLC,
16 and Mental Health Systems, P.C., and that Dr. Pederson has other business interests.

17 22. Defendants deny the allegations of paragraph 22.

18 23. As to paragraph 23, Defendants admit that, as an author, speaker, and in training
19 other dialectical behavior therapy (DBT) practitioners, Dr. Pederson refers to dialectical behavior
20 therapy by its commonly known associated acronym DBT. In further answer, Dr. Pederson
21 admits that he has used Plaintiff’s name solely to acknowledge her contribution to the
22 development of DBT to treat patients with a high risk of suicide and to disclaim any association
23 with Plaintiff or her affiliates. Defendants deny that Dr. Pederson consistently uses Dr. Linehan’s
24 name.

25 24. Defendants deny the allegations of paragraph 24. In further answer, in July 2017,
26 Evergreen Certifications, Inc., a Wisconsin corporation, acquired substantially all of the assets of

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1 CBS, excluding CBS's trademarks **DBTNCAA** and **DIALECTICAL BEHAVIOR THERAPY**
2 **NATIONAL CERTIFICATION AND ACCREDITATION ASSOCIATION**, under terms
3 that prohibit CBS from competing with Evergreen's certification business. After a short period of
4 transition, CBA ceased issuing certifications or accreditations relating to dialectical behavior
5 therapy (DBT).

6 25. As for the allegations of paragraph 25, Defendants admit that Plaintiff contributed
7 to the development of dialectical behavior therapy (DBT) to treat patients with a high risk of
8 suicide. In further answer, Defendants state that the cited book speaks for itself. Defendants deny
9 the remaining allegations of paragraph 25.

10 26. Defendants deny the allegations of paragraph 26. With respect to the brochures
11 alleged therein, Defendants affirmatively allege that Dr. Pederson authored only his biography
12 and the program description, learning objectives and program outline contained therein, which
13 do not feature or refer to Plaintiff. Defendants did not author or prepare any other portions of
14 said brochures and did not distribute or disseminate them.

15 27. Defendants deny the allegations of paragraph 27. With respect to the brochures
16 alleged therein, Defendants affirmatively allege that Dr. Pederson authored only his biography
17 and the program description, learning objectives and program outline contained therein, which
18 do not feature or refer to Plaintiff. Defendants did not author or prepare any other portions of
19 said brochures and did not distribute or disseminate them.

20 28. Defendants deny the allegations of paragraph 28. With respect to the brochures
21 alleged therein, Defendants affirmatively allege that Dr. Pederson authored only his biography
22 and the program description, learning objectives and program outline contained therein, which
23 do not feature or refer to Plaintiff. Defendants did not author or prepare any other portions of
24 said brochures and did not distribute or disseminate them.

25 29. Defendants deny the allegations of paragraph 29. With respect to the brochures
26 alleged therein, Defendants affirmatively allege that Dr. Pederson authored only his biography

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1 and the program description, learning objectives and program outline contained therein, which
 2 do not feature or refer to Plaintiff. Defendants did not author or prepare any other portions of
 3 said brochures and did not distribute or disseminate them.

4 **FIRST CAUSE OF ACTION**

5 **Trademark Infringement and False Designation of Origin**

6 **Pursuant to 15 U.S.C. § 1125(a)**

7 30. Defendants repeat and reallege the preceding answers to the Complaint and
 8 incorporate the same by reference herein.

9 31. Defendants deny the allegations of paragraph 31. In further answer, Defendants
 10 deny that Plaintiff has any trademark rights in the terms “dialectical behavior therapy” and
 11 “DBT.”

12 32. As for paragraph 32, Defendants admit that Dr. Pederson has provided and
 13 continues to provide training, educational, and therapy services and products using the terms
 14 “dialectical behavior therapy” and its commonly used associated acronym “DBT.” CBS admits
 15 that it has used its registered trademarks **DBTNCAA** and **DIALECTICAL BEHAVIOR**
 16 **THERAPY NATIONAL CERTIFICATION AND ACCREDITATION ASSOCIATIONS.**
 17 In further answer, Defendants deny that the logo infringed upon any trademark rights of Plaintiff
 18 and deny the remaining allegations of paragraph 32.

19 33. Defendants deny the allegations of paragraph 33.

20 34. Defendants deny the allegations of paragraph 34.

21 35. Defendants deny the allegations of paragraph 35.

22 **SECOND CAUSE OF ACTION**

23 **False Endorsement Pursuant to 15 U.S.C. § 1125(a)**

24 36. Defendants repeat and reallege the preceding answers to the Complaint and
 25 incorporate the same by reference herein.

26 37. Defendants deny the allegations of paragraph 37.

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38. Defendants deny the allegations of paragraph 38. In further answer, Defendants routinely disclaim any association with Plaintiff or her goods and services. At all times relevant, CBS's website contained the following disclaimer: "DBTNCAA is not associated with Dr. Linehan, her training company, or her other affiliations."

39. Defendants deny the allegations of paragraph 39.

40. Defendants deny the allegations of paragraph 40.

41. Defendants deny the allegations of paragraph 41.

THIRD CAUSE OF ACTION

Violation of Washington Consumer Protection Act, RCW 19.86.020. et seq.

42. Defendants repeat and reallege the preceding answers to the Complaint and incorporate the same by reference herein.

43. Defendants deny the allegations of paragraph 43.

44. Defendants deny the allegations of paragraph 44.

45. Defendants deny the allegations of paragraph 45.

OTHER DEFENSES

46. The Complaint fails to state a claim upon which relief can be granted.

47. Plaintiff lacks standing to seek relief based on the claims alleged in the Complaint.

48. Plaintiff's claims are barred by the doctrine of fair use.

49. Plaintiff's claims are barred by public policy.

50. Plaintiff's alleged trademarks **DBT** and **DIALECTICAL BEHAVIOR THERAPY** (collectively, the "Marks") are or have become generic. A generic mark cannot be registered under any circumstances.

51. If the Marks are not adjudicated to be generic, the marks are merely descriptive of the services and are incapable of acquiring any secondary meaning, as Plaintiff cannot show substantial exclusivity of use.

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52. If Plaintiff ever had any rights in the Marks, she abandoned those rights by failing to use the terms “dialectical behavior therapy” and “DBT” as trademarks or service marks, by failing to police use of the Marks by third parties to prevent the erosion of distinctiveness, and by failing to control the quality of goods and services offered by other persons under the terms “dialectical behavior therapy” or “DBT.”

53. There is no likelihood of confusion between the Marks and Defendants’ use of the terms “dialectical behavior therapy” and its commonly used associated acronym “DBT” because the Marks are generic or, alternatively, merely descriptive.

54. Plaintiff committed fraud on the USPTO in her applications to register the terms **DBT** and **DIALECTICAL BEHAVIOR THERAPY** by knowingly making false representations to the USPTO with intent to deceive. Those false representations were material and were relied upon by the examiner in issuing U.S. Trademark Registration No. 4,204,315 and in publishing U.S. Trademark Application No. 86,539,349 for opposition.

55. Despite Plaintiff’s knowledge that tens of thousands of therapists and educators use the terms “dialectical behavior therapy” and “DBT” to describe their services, Plaintiff singled out Dr. Pederson, commencing this action against him in bad faith and for the purpose of harassing and oppressing Dr. Pederson and his business interests.

56. Plaintiff’s claims are barred by the doctrine of unclean hands.

57. Plaintiff’s claims are barred by laches.

58. Plaintiff’s claims are barred by the doctrine of acquiescence.

59. Plaintiff’s claims are barred by the doctrines of estoppel and waiver.

60. Plaintiff would be unjustly enriched if allowed to recover on the claims asserted in the Complaint.

61. Plaintiff failed to mitigate her damages. Despite Plaintiff’s knowledge, for a period of many years, of the facts upon which her claims rely, Plaintiff, up until the day this lawsuit was commenced, failed to make Defendants aware of her concerns and claims, failed to

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1 request that Defendants cease and desist from the acts now complained of and failed to take any
2 action to mitigate her damages.

3 62. Plaintiff's causes of action may be barred by any and all of the affirmative
4 defenses contemplated by Rule 8(c) of the Federal Rules of Civil Procedure, which are
5 incorporated herein.

6 63. Defendants reserve the right to amend and supplement this Answer and to reply
7 upon affirmative and other defenses revealed in the course of investigation and discovery in this
8 action.

9 **COUNTERCLAIM**

10 Lane Pederson ("Dr. Pederson"), as and for his Counterclaim against Counter-defendant
11 Marsha M. Linehan ("Counter-defendant"), states as follows:

12 **PARTIES, JURISDICTION, AND VENUE**

13 1. Dr. Pederson is an individual who resides in the state of Minnesota.

14 2. Upon information and belief, Counter-defendant is an individual who resides in
15 the State of Washington.

16 3. This counterclaim arises out of the Complaint, which alleges violations of and
17 seeks remedies under federal trademark law and the Washington Consumer Protection Act.

18 4. The Court has original jurisdiction over this action pursuant to 28 U.S.C. § 1331
19 and supplemental jurisdiction over Plaintiff's state law claim pursuant to 28 U.S.C. § 1367. In
20 addition, the Court has jurisdiction over the counterclaim seeking cancellation of a trademark in
21 an action involving the registration of that trademark and opposing registration of a trademark
22 pursuant to 15 U.S.C. § 1119.

23 5. The Court has personal jurisdiction over Counter-defendant because she resides in
24 the state of Washington.

25 6. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b)(1)-(2).
26

FACTS

7. Dr. Pederson is a well-known, well-respected dialectical behavior therapy practitioner and educator. He has written several books on dialectical behavior therapy, which is commonly known by its associated acronym DBT, including: THE EXPANDED DIALECTICAL BEHAVIOR THERAPY SKILLS TRAINING MANUAL, 2ND EDITION (PPM, 2017); DIALECTICAL BEHAVIOR THERAPY: A CONTEMPORARY GUIDE FOR PRACTITIONERS (Wiley, 2015); DIALECTICAL BEHAVIOR THERAPY SKILLS TRAINING IN INTEGRATED DUAL DISORDER TREATMENT SETTINGS (PPM, 2013).

8. Dr. Pederson has been conducting seminars on DBT since 2003 and has provided consulting and training on DBT to over 10,000 mental health professionals throughout the United States, Australia, Canada, Mexico, South Africa and the Middle East. Dr. Pederson has provided DBT services to such notable organizations as the American Psychological Association, the Federal Bureau of Prisons, the United States Navy, and Walter Reed Hospital, among others.

9. Dr. Pederson is co-owner of Mental Health Systems, P.C. (“MHS”), a Minnesota corporation that, since 2002, has provided dialectical behavior therapy (DBT) for clients with many different types of mental and chemical health conditions and provides education and training services to individuals and groups in the practice of DBT. MHS adherent-based DBT practice is certified by the Minnesota Department of Human Services.

10. In 2010, Dr. Pederson co-founded Cognitive and Behavioral Specialties (“CBS”), the first active, national organization for dialectical behavior therapy (DBT) providers and programs. CBS is the owner of Registration No. 4,099,711 for the mark DBTNCAA, filed May 25, 2010, and issued February 14, 2012, and Registration No. 4,214,437 for the mark DIALECTICAL BEHAVIOR THERAPY NATIONAL CERTIFICATION AND ACCREDITATION ASSOCIATION & DESIGN (which disclaims the descriptive words “dialectical behavior therapy”), filed May 25, 2010, and issued September 25, 2012. Both marks

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1 are registered as certification marks used by CBS since 2011 to certify therapists who have
2 fulfilled certain standards of education, training, and practice in the field of dialectical behavior
3 therapy (DBT). CBS had more than 1,700 members and 229 DBT certified therapists from the
4 United States, Canada and Australia.

5 11. Dr. Pederson is an independent contractor for PESI, Inc. (“PEI”), a Wisconsin
6 non-profit corporation offering training, continuing education, publications, and conferences on
7 DBT to mental health professionals nationwide.

8 12. Dr. Pederson, along with tens of thousands of therapists nationwide and
9 internationally, use the term DBT as the generic name for an increasingly popular form of
10 psychological therapy, known as dialectical behavior therapy, and use the acronym generically in
11 connection with training and educating practitioners in the practice of DBT, as well as in
12 developing and promoting DBT programs and authoring and in publishing books, articles, and
13 training materials concerning DBT.

14 13. In addition to the tens of thousands of therapists providing DBT, many other
15 organizations and individuals, use the term DBT as the generic name for a type of therapy known
16 as dialectical behavior therapy, including but not limited to physicians, healthcare clinics,
17 hospitals, insurance providers, universities, authors, researchers, training organizations and
18 governmental agencies of several states. The relevant public has come to know and recognize
19 dialectical behavior therapy, or DBT, as a generic category of therapy used to treat a wide range
20 of mental and chemical health conditions.

21 14. In prosecuting applications for federal trademarks, Counter-defendant owed and
22 continues to owe the USPTO a continuing duty of good faith and candor.

23 **U.S. Trademark Application Serial No. 78,655,056**

24 15. On July 29, 1998, Counter-defendant founded the Marie Institute of Behavioral
25 Technology, now known as The Linehan Institute. On December 27, 2002, Counter-defendant
26 founded Behavioral Tech, LLC (“Behavioral Tech”), for the purpose of training practitioners in

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1 dialectical behavior therapy (DBT). The Linehan Institute is Behavioral Tech's sole member.
2 Counter-defendant purportedly "allowed" The Linehan Institute and Behavioral Tech to use the
3 terms "dialectical behavioral therapy" and "DBT."

4 16. On June 21, 2005, Behavioral Tech filed U.S. Trademark Application No.
5 78,655,056 to register the mark **DIALECTICAL BEHAVIOR THERAPY INTENSIVE**
6 **TRAINING** (standard character mark) under Section 1(a) and 2(f) of the Lanham Act, 15 U.S.C.
7 § 1051(a), claiming a date of first use at least as early as March 29, 1992. The application
8 covered "Consultation and training for mental health systems and professionals" in International
9 Class 44. Applicant Behavioral Tech claimed acquired distinctiveness in the mark based on
10 "substantially exclusive and continuous use of the mark for at least five years immediately before
11 the date of this statement." At that time, Counter-defendant knew that she had not made
12 substantially exclusive use of the term "dialectical behavior therapy."

13 17. In an Office Action issued on January 18, 2006, U.S. Trademark Application No.
14 78,655,056 was refused under Section (e)(1) of the Lanham Act as being "highly descriptive of
15 the goods and/or services." Behavioral Tech was advised by the trademark examiner that
16 "[a]dditional evidence is needed to support the claim of distinctiveness. Applicant's allegation of
17 five years' use alone is insufficient evidence of distinctiveness in this case because applicant's
18 mark is highly descriptive of the goods and/or services."

19 18. After Behavioral Tech failed to respond to the Office Action, the USPTO issue a
20 Notice of Abandonment on August 17, 2006.

21 **U.S. Trademark Registration No. 4,204,315**

22 19. Counter-defendant claims trademark rights in the mark **DBT**, as shown in U.S.
23 Trademark Registration No. 4,204,315.

24 20. On October 26, 2010, Counter-defendant applied to register the mark **DBT**
25 (standard character mark) under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), in
26 International Class 41 for "Educational services, namely, conducting classes, seminars,

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1 workshops and conferences in the field of clinical psychology and distribution of training and
2 course materials in connection therewith,” and in International Class 44 for “Psychotherapy
3 services; research and development of treatments in the field of clinical psychology; providing
4 scientific information in the field of clinical trials.” Counter-defendant claimed use of the mark
5 since at least as early as March 31, 1993.

6 21. Counter-defendant’s application to register the mark **DBT** was refused under
7 Section 2(e)(1) of the Lanham Act as being merely descriptive of the services. In addition, the
8 examiner noted that the applied-for mark “appears to be generic in connection with the identified
9 services and, therefore, incapable of functioning as a source-identifier for applicant’s services.”
10 After Counter-defendant failed to respond to the Office Action, the USPTO issued a Notice of
11 Abandonment. On September 2, 2011, Counter-defendant filed a Petition to Revive, which was
12 granted on November 3, 2011, setting a new deadline of May 3, 2012, to respond to the Office
13 Action.

14 22. On May 4, 2012, one day after the due date for the response, Counter-defendant
15 responded to the Office Action, claiming that she was responding to the office action issued on
16 November 4, 2011, arguing:

17 a. that the mark **DBT** is not merely descriptive because “DBT” does not
18 describe the services covered by the application;

19 b. that the term “DBT” stands for “dialectical behavior therapy” and that
20 dialectical behavior therapy “remains specific to Dr. Linehan’s groundbreaking therapy”;

21 c. that the term “DBT” is “nothing more than three letters”; and

22 d. that the term “DBT” “does not serve as the common name of the services
23 with which the Mark is associated.”

24 At that time, Counter-defendant knew that the term “DBT” was commonly used by tens of
25 thousands of individuals and organizations in the United States and internationally to describe a
26 type of therapy commonly known as “dialectical behavior therapy.” She herself used the term

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1 DBT throughout the response in place of the words “dialectical behavioral therapy.” In making
2 such materially false representations, Counter-defendant breached her duty to good faith and
3 candor and acted with intent to deceive.

4 23. Inexplicably, despite that Counter-defendant’s response was filed one day past the
5 statutory deadline, the USPTO accepted the response. In reliance on Counter-defendant’s
6 materially false representations, the USPTO published the mark **DBT** for opposition in the
7 *Official Gazette* on June 26, 2012.

8 24. On September 11, 2012, the mark **DBT** was registered, as shown by Registration
9 No. 4,204,315.

10 **U.S. Trademark Application Serial No. 86,539,349**

11 25. On February 19, 2015, Counter-defendant filed U.S. Trademark Application No.
12 86,539,349 to register the purported mark **DIALECTICAL BEHAVIOR THERAPY** (standard
13 character mark) for “Educational services, namely conducting classes, seminars, workshops and
14 conferences in the field of clinical psychology and distribution of training and course materials in
15 connection therewith.” Counter-defendant filed the application under Section 1(a) of the Lanham
16 Act, claiming use of the mark in commerce since “at least as early as” March 31, 1993.

17 26. The USPTO refused Application No. 86,539,349 under Section 2(e) of the
18 Lanham Act as being merely descriptive of Counter-defendant’s services. On September 15,
19 2015, Counter-defendant responded to the refusal, representing:

20 a. that the term “dialectical behavior therapy” “remains specific to Dr.
21 Linehan’s groundbreaking therapy”; and

22 b. that, “[w]ithout conceding that the mark is descriptive, . . . the mark has
23 become distinctive of Applicant’s goods or services through the Applicant’s (and
24 licensees’) substantially exclusive and continuous use in commerce for at least five years
25 immediately before the date of this statement.”
26

1 At that time, Counter-defendant knew that she had not made substantially exclusive use of the
2 term “dialectical behavior therapy” and that the term “dialectical behavior therapy” was
3 commonly used by tens of thousands of individuals and organizations in the United States and
4 internationally to describe a type of cognitive behavior therapy.

5 27. In a second Office Action issued on September 18, 2015, the USPTO maintained
6 its refusal of U.S. Trademark Application No. 86,539,349 under Section 2(e) of the Lanham Act
7 and informed Counter-defendant that, if she intended to make a claim of acquired distinctiveness
8 under Section 2(f), she must amend the application to enter the required statement of
9 distinctiveness in the mark and that she must verify this statement with an affidavit or signed
10 declaration under 37 C.F.R. § 2.20.

11 28. On March 18, 2016, Counter-defendant amended her application to include a
12 claim of acquired distinctiveness under Section 2(f) of the Lanham Act, again representing
13 “substantially exclusive and continuous use of the mark [**DIALECTICAL BEHAVIOR**
14 **THERAPY**] in commerce . . . for at least five years immediately before the date of this
15 statement.” Counter-defendant did not verify the statement with an affidavit or signed
16 declaration, as required by 37 C.F.R. § 2.20 and as instructed by the examiner. Instead, Counter-
17 defendant’s counsel “elected not to submit the signed declaration” purportedly because counsel
18 believed “that no supporting declaration is required under the *Trademark Rules of Practice*.”

19 29. At the time that Counter-defendant made the claim of acquired distinctiveness
20 with respect to U.S. Trademark Application No. 86,539,349, Counter-defendant knew that she
21 had not made substantially exclusive use of the term “dialectical behavior therapy” and that the
22 term “dialectical behavior therapy” was commonly used by tens of thousands of individuals and
23 organizations in the United States and internationally to describe a type of cognitive behavior
24 therapy. In making the materially false representation of acquired distinctiveness, Counter-
25 defendant breached her duty of good faith and candor and acted with intent to deceive.
26

30. In reliance on Counter-defendant's materially false representation of acquired distinctiveness, the mark **DIALECTICAL BEHAVIOR THERAPY** was published for opposition in the *Official Gazette* on May 17, 2016.

31. The registration of the mark **DBT** affords Counter-defendant a *prima facie* exclusive right to use the mark for the services identified in the application. If the registration is not cancelled and if U.S. Application No. 86,539,349 for the purported mark **DIALECTICAL BEHAVIOR THERAPY** is not refused, Dr. Pederson and tens of thousands of others will be damaged because there will be a doubt as to their ability to use the terms, "dialectical behavior therapy" and its commonly known associated acronym DBT, as the terms have been used for many years, to describe the dialectical behavior therapy (DBT) services and the associated training, research, and educational services offered by Dr. Pederson and others throughout the United States and internationally. If this Court does not grant the relief sought herein, Counter-defendants' actions, undertaken for Counter-defendant's own personal financial gain, will cause severe and irreparable harm to Defendants and the public at large by preventing or stifling the ability of psychologists, physicians, healthcare clinics, hospitals, insurance providers, universities, authors, researchers, training organizations and governmental agencies from providing and accessing dialectical behavior therapy services, commonly known as DBT services, from conducting necessary and appropriate training and education relating thereto and from advancing the science of psychology to the detriment of patients and the public good.

COUNT I

Cancellation of U.S. Trademark Registration No. 4,204,315 – Genericness

(15 U.S.C. §§ 1064 and 1119)

32. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

33. The mark **DBT** is incapable of distinguishing Counter-defendant's services from the services of others, because Dr. Pederson and others for many years have used and continue to

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1 use and have the right to use the term DBT generically as the acronym for the generic term
2 dialectical behavior therapy. The acronym DBT has no separate meaning apart from the
3 underlying term dialectical behavior therapy and, in the context of mental health services, is
4 commonly understood to mean dialectical behavior therapy.

5 34. A generic mark cannot be registered under any circumstances.

6 35. The continuing registration of the mark **DBT** threatens damage and injury to Dr.
7 Pederson, his clients, his patients, and others who use and have a right to use DBT to describe
8 their services.

9 36. Dr. Pederson is entitled to cancellation of U.S. Trademark Registration No.
10 4,204,315 based upon genericness.

11 **COUNT II**

12 **Cancellation of U.S. Trademark Registration No. 4,204,315 – Mere Descriptiveness**

13 **(15 U.S.C. §§ 1052(e), 1115, and 1119)**

14 37. Dr. Pederson realleges the preceding allegations of the Counterclaim and
15 incorporates the same herein by reference.

16 38. If the mark **DBT** is not deemed to be generic, it is merely descriptive of the
17 services and is incapable of acquiring secondary meaning, as Counter-defendant cannot show
18 substantial exclusivity of use.

19 39. The continuing registration of the mark **DBT** threatens damage and injury to Dr.
20 Pederson, his clients, his patients, and others who use and have a right to use DBT to describe
21 their services.

22 40. Dr. Pederson is entitled to cancellation of U.S. Trademark Registration No.
23 4,204,315 based upon mere descriptiveness.

24 **COUNT III**

25 **Cancellation of U.S. Trademark Registration No. 4,204,315 – Abandonment**

26 **(15 U.S.C. §§ 1115 and 1119)**

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41. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

42. To the extent Counter-defendant ever had any rights in the term DBT, she abandoned such rights by failing to properly use the term as a trademark or service mark, by failing to police use of the mark by third parties to prevent the erosion of distinctiveness, and by failing to control the quality of goods and services offered by other parties under the term DBT.

43. The continuing registration of the mark **DBT** threatens damage and injury to Dr. Pederson, his clients, his patients, and others who use and have a right to use DBT to describe their services.

44. Dr. Pederson is entitled to cancellation of U.S. Trademark Registration No. 4,204,315 based upon abandonment.

COUNT IV

Cancellation of U.S. Trademark Registration No. 4,204,315 – Fraud on the USPTO (15 U.S.C. §§ 1115, 1119, 1120)

45. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

46. In prosecuting her application to register the mark **DBT**, Counter-defendant made materially false representations to the USPTO. At that time, Counter-defendant knew that her representations were false.

47. Based on the foregoing, Counter-defendant could not possibly have had a good faith belief that she made “substantially exclusive” use of the term “DBT” in connection with the covered services in the five years before making her claim of acquired distinctiveness in March 2016. In making the materially false representations, Counter-defendant breached her duty of good faith and candor and acted with the intent to deceive.

48. In reliance on Counter-defendant’s materially false representations, the mark **DBT** was registered, as shown by Registration No. 4204315.

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49. Based on the foregoing, Counter-defendant committed a fraud on the USPTO.

50. The continuing registration of the mark **DBT** threatens damage and injury to Dr. Pederson, his clients, his patients, and others who use and have a right to use DBT to describe their services.

51. Dr. Pederson is entitled to cancellation of U.S. Trademark Registration No. 4,204,315 based upon Counter-defendant's fraud on the USPTO.

COUNT V

Opposition to Registration U.S. Trademark Application Serial No. 86,539,349 - Genericness

(15 U.S.C. §§ 1063 and 1119)

52. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

53. The purported mark **DIALECTICAL BEHAVIOR THERAPY** is incapable of distinguishing Counter-defendant's services from the services of others, because Dr. Pederson and others for many years have used and continue to use and have the right to use the term "dialectical behavior therapy" generically.

54. A generic mark cannot be registered under any circumstances.

55. If Counter-defendant is able to obtain registration for the purported mark **DIALECTICAL BEHAVIOR THERAPY**, Dr. Pederson and others will be damaged because there will be doubt as to their ability to use the term "dialectical behavior therapy" as it has been used for many years to describe the type of therapy services and the type of educational and training services offered by Dr. Pederson and others.

56. Dr. Pederson is entitled to refusal of U.S. Trademark Application No. 86,539,349 based upon genericness.

COUNT VI

Opposition to Registration
U.S. Trademark Application Serial No. 86,539,349 – Mere Descriptiveness
(15 U.S.C. §§ 1052(e), 1063, 1119)

57. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

58. If the purported mark **DIALECTICAL BEHAVIOR THERAPY** is not deemed to be generic, it is merely descriptive of the services and is incapable of acquiring secondary meaning, as Counter-defendant cannot show substantial exclusivity of use.

59. If Counter-defendant is able to obtain registration for the purported mark **DIALECTICAL BEHAVIOR THERAPY**, Dr. Pederson and others will be damaged because there will be doubt as to their ability to use the term “dialectical behavior therapy” as it has been used for many years to describe the type of therapy services and the type of educational and training services offered by Dr. Pederson and others.

60. Dr. Pederson is entitled to refusal of U.S. Trademark Application No. 86,539,349 based upon mere descriptiveness.

COUNT VII

Opposition to Registration
U.S. Trademark Application Serial No. 86,539,349 - Abandonment
(15 U.S.C. §§ 1063 and 1119)

61. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

62. To the extent Counter-defendant ever had any rights in the term dialectical behavior therapy, she has abandoned such rights by failing to use the term properly as a trademark or service mark, by failing to police use of the mark by third parties to prevent the erosion of distinctiveness, and by failing to control the quality of goods and services offered by other parties under the term “dialectical behavior therapy.”

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63. Counter-defendant thus abandoned any rights that she may have had to the purported mark **DIALECTICAL BEHAVIOR THERAPY** due to a course of conduct that has caused the purported mark to lose significance as an indication of source.

64. If Counter-defendant is able to obtain registration for the purported mark **DIALECTICAL BEHAVIOR THERAPY**, Dr. Pederson and others will be damaged because there will be doubt as to their ability to use the term “dialectical behavior therapy” as it has been used for many years to describe the type of therapy services and the type of educational and training services offered by Dr. Pederson and others.

65. Dr. Pederson is entitled to refusal of U.S. Trademark Application No. 86,539,349 based upon abandonment.

COUNT VIII

Opposition to Registration

U.S. Trademark Application Serial No. 86,539,349 – Fraud on the USPTO

(15 U.S.C. §§ 1063 and 1119)

66. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

67. Counter-defendant willfully made a false statement in asserting acquired distinctiveness by claiming (without the required declaration under Section 2(f) of the Lanham Act) that the purported mark **DIALECTICAL BEHAVIOR THERAPY** “has become distinctive of the goods and/or services through Counter-defendant’s substantially exclusive and continuous use of the mark in commerce ... for at least five years immediately before the date of this statement.”

68. Counter-defendant knowingly made a false representation to the USPTO. Counter-defendant has personal knowledge of the use of the term “dialectical behavior therapy” by tens of thousands of other practitioners and educators, including Dr. Pederson, many of which have been trained by the Counter-defendant to practice dialectical behavior therapy without

1 restriction or license. Counter-defendant also had constructive notice of CBS's U.S. Registration
 2 No. 4,214,437 for a substantially similar mark covering substantially similar services. Thus,
 3 Counter-defendant could not possibly have had a good faith belief that she made "substantially
 4 exclusive" use of the term "dialectical behavior therapy" in connection with the covered services
 5 in the five years before making her claim of acquired distinctiveness in March 2016, as claimed
 6 by Counter-defendant in U.S. Trademark Application No. 86,539,349 and in argument in
 7 response to the USPTO's Office Actions.

8 69. Counter-defendant's false representation to the USPTO concerns a fact material to
 9 a determination of acquired distinctiveness under Section 2(f) of the Lanham Act. The USPTO
 10 relied on Counter-defendant's false representation in publishing the purported mark
 11 **DIALECTICAL BEHAVIOR THERAPY** for opposition.

12 70. Based on the foregoing, Counter-defendant committed a fraud on the USPTO.

13 71. If Counter-defendant is able to obtain registration for the purported mark
 14 **DIALECTICAL BEHAVIOR THERAPY**, Dr. Pederson and others will be damaged because
 15 there will be doubt as to their ability to use the term "dialectical behavior therapy" as it has been
 16 used for many years to describe the type of therapy services and the type of educational and
 17 training services offered by Dr. Pederson and others.

18 72. Dr. Pederson is entitled to refusal of U.S. Trademark Application No. 86,539,349
 19 based upon Counter-defendant's fraud on the USPTO.

20 **COUNT IX**

21 **Declaration of Non-Infringement**

22 **(28 U.S.C. §§ 2201, 2202)**

23 73. Dr. Pederson realleges the preceding allegations of the Counterclaim and
 24 incorporates the same herein by reference.

25 74. In each instance in which Dr. Pederson used the terms "dialectical behavior
 26 therapy" and "DBT," he did so solely as generic terms or, alternatively, for descriptive purposes.

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75. In her Complaint, Counter-defendant alleges that Dr. Pederson’s generic or descriptive use of the terms “dialectical behavior therapy” and “DBT” constitutes trademark infringement, false designation of origin, false endorsement, and unfair competition under the Washington Consumer Protection Act. Dr. Pederson denies the allegations.

76. Based on the foregoing, an actual controversy exists between the parties as to Dr. Pederson's rights to use the terms "dialectical behavior therapy" and "DBT."

77. Dr. Pederson is entitled to a declaratory judgment that use of the terms “DBT” and “dialectical behavior therapy” does not infringe upon any trademark rights of the Counter-defendant.

COUNT X

Abuse of Process

78. Dr. Pederson realleges the preceding allegations of the Counterclaim and incorporates the same herein by reference.

79. Despite Counter-defendant's personal knowledge that tens of thousands of practitioners and educators use the terms "dialectical behavior therapy" and "DBT," she commenced this trademark infringement action against Dr. Pederson out of personal animus and in bad faith.

80. The claims asserted by Counter-defendant against Dr. Pederson are objectively baseless. Counter-defendant nevertheless persists in abusive litigation for the purpose of harassing and oppressing Dr. Pederson and his business interests.

81. Based on the foregoing, this is an exceptional case under the Lanham Act, warranting an award of reasonable attorney fees to Dr. Pederson pursuant to 15 U.S.C. § 1117.

REQUEST FOR RELIEF

WHEREFORE, Dr. Pederson and CBS respectfully request that the Court enter judgment in their favor as follows:

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Perkins Coie LLP
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1 a. That the Complaint and each and every purported claim for relief therein be
2 dismissed with prejudice;

3 b. That the Court issue an order to the USPTO cancelling U.S. Trademark
4 Registration No. 4,204,315;

5 c. That the Court issue an order to the USPTO refusing U.S. Trademark Application
6 Serial No. 86,539,349;

7 d. That the Court issue a declaration that Dr. Pederson's use of the terms "dialectical
8 behavior therapy" and "DBT" does not infringe upon any valid trademark of Counter-defendant.

9 e. That Plaintiff/Counter-defendant is liable to Dr. Pederson pursuant to U.S.C.
10 § 1120;

11 f. That the Court determine that this is an exceptional case under 15 U.S.C. § 1117
12 and award Dr. Pederson his reasonable attorney fees incurred in connection with this action;

13 g. For an award of costs and disbursements; and

14 h. For such other and further relief as the Court deems just and equitable.

1
2 DATED: November 21, 2017

PERKINS COIE LLP

By: s/William C. Rava

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National Certification and Accreditation Association

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ANSWER AND COUNTERCLAIM (No. 2:17-
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CERTIFICATE OF SERVICE

I certify under penalty of perjury that on November 21, 2017, I electronically filed the foregoing ANSWER AND COUNTERCLAIM with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

DATED this 21st day of November, 2017.

s/ William C. Rava
William C. Rava